

16. (New) The method according to claim 12, wherein the act of entering remarks in the program about the individual comprises an act of inputting in the program at least one of text and voice.

17. (New) The method according to claim 12, wherein the act of instructing the same apparatus to transmit the image comprises an act of instructing the same apparatus to transmit the image via a wireless connection.

18. (New) The method according to claim 12, wherein the act of instructing the same apparatus to transmit the image comprises an act of instructing the same apparatus to transmit the image via the Internet.

19. (New) The method according to claim 12, wherein the act of instructing the apparatus to capture, together with the imager, at least one of a) a streaming video digital image of the individual at a first location or b) a still digital image of the individual at a first location comprises an act of instructing the apparatus to capture, together with the imager, a still digital image of the individual at a first location.

20. (New) The method according to claim 12, wherein the act of instructing the apparatus to capture, together with the imager, at least one of a) a streaming video digital image of the individual at a first location or b) a still digital image of the individual at a first location comprises an act of instructing the apparatus to capture, together with the imager, a streaming video digital image of the individual at a first location.

### **REMARKS**

#### *Claim Rejections – 35 USC §102(b)*

Claims 1-4 and 6-8 are rejected under 35 USC §102(b) as being anticipated by Wang. Without acceding to the propriety of the rejection, Applicant has amended claim 1, as noted. In particular, Applicant has amended claim 1 to recite *inter alia*, “a transmitter coupled to the

computer and adapted to electronically transmit at least one of the identifying information and remarks to a second location remote from the first location”, “a receiver coupled to the computer and adapted to receive instructions from the second location, the instructions comprising an action the user of the apparatus should take regarding the individual”, and “an output device coupled to the computer and adapted to inform the user of the apparatus of the instructions”. Support for this amendment is found in Figure 1 and on page 31, lines 9-14 (“As described above, the apparatus 20 may communicate with a central location and may receive data from the central location including instruction information. When used as a security apparatus, the user may receive information on how to proceed when confronted with a situation wherein the apparatus 20 is used to identify a suspect. For example, the information may include instructions on how the security personnel should act or what actions should be taken to arrest, detain or otherwise deter the suspect.”)

It is respectfully submitted that Wang does not teach or disclose transmitting the identifying data to a remote location and informing the user of the apparatus of an action the user should take, as claimed in claim 1. Therefore, the rejection of claims 1-4 and 6-8 as being anticipated by Wang should be withdrawn.

#### *Claim Rejection – 35 USC §103(a)*

Claim 5 stands rejected as being unpatentable over Wang in view of Musgrave. This rejection is traversed.

Claim 1 has been rewritten to include at least some of the substance of claim 5. In particular, claim 1 has been amended to recite, “a transmitter coupled to the computer and adapted to electronically transmit at least one of the identifying information and remarks to a second location remote from the first location”. Therefore, for at least the reasons discussed below, Applicant requests reconsideration.

#### A. Motivation Not Proper

Applicant submits that the proposed combination is improper because the combination would be unsatisfactory for its intended purpose. According to MPEP 2143.01, “if [the] proposed modification would render the prior art invention being modified unsatisfactory for its

intended purpose, then there is no suggestion or motivation to make the proposed modification.”

The Examiner states that one of skill in the art would have been motivated to modify Wang with the teachings of Musgrave because “doing this will provide a fraud free system.”

(Office Action, page 5)

Wang indicates at columns 1 and 2 that a primary function of the system is to aid a user in recalling names of people previously met. Specifically, at column 1, lines 14-19, Wang states,

“As is known, human nature typically shows that people want to be recognized by others. Thus, it is important for people to recognize and recall the names of other people they have previously met or acquainted during meetings, social functions, or other occasions. Not recognizing the person before you may affect you adversely.”

To obtain this goal, Wang is directed to a personal identifier and management system that includes a device to capture an image of a person and compare it to images stored in a database so as to enable a user to recall an individual’s name. If no match is obtained, the user is then given the option to store the image into the database. Specifically, as stated at column 6, lines 1-11,

“If no matching face feature data is found in the profile database 13, it means that none of the stored face images in the profile database 13 is similar to the input face image. In this case, the analysis system 12 makes such indication to the user. *The user can then have the option of storing the input face image in the profile database 13, along with the associated face feature data and the person-identifying data.* Before storing the input face image into the profile database 13, the analysis system 12 asks the user to input the person-identifying data of the input face image via the input/output system 11.” (Emphasis added)

On the other hand, as recognized by the Examiner, Musgrave teaches a cellular phone that will not allow calls to be placed unless the correct user is identified. Specifically, Musgrave teaches a cellular phone that captures an iris image of the user and transmits the image to a cellular provider where a comparison to stored iris images is made. If the user is not identified, then authorization to use the phone is not granted and the phone remains locked. See, for example, the last line of the Abstract, “The telephone cannot be unlocked and used unless a user has been identified and authorized by the imager.”

It is respectfully submitted that one of skill in the art would not have been motivated to modify Wang with the “fraud free system” of Musgrave because doing so would render the resulting combination unsatisfactory for its intended purpose. In this respect, if the identifying information were transmitted to a remote location and the person being identified was not in the database, then the modified Wang system would remain locked and the user would be unable to store “the input face image in the profile database 13, along with the associated face feature data and the person-identifying data” as deemed important in Wang. Simply put, if the “fraud free system” of Musgrave were incorporated into the Wang system, one would not be able to add new images and data for future retrieval, thereby defeating one of the stated purposes of the Wang system. Accordingly, the rejection of claim 5 (at least a portion of which is now included in claim 1) as being unpatentable over Wang in view of Musgrave should be withdrawn.

B. Resulting Combination Does Not Teach or Suggest All the Limitations of the Claim

Furthermore, even if one were motivated to modify Wang with the transmitting and receiving feature of Musgrave, the resulting combination does not teach all the limitations of the claims. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03. Applicant respectfully submits that the combination of Wang with Musgrave neither teaches nor suggests all the limitations of the claims.

The Office Action indicates that Wang teaches all of the claimed elements except for the apparatus being adapted to communicate with a remote location to at least one of transmit and receive identifying information. However, as now amended, claim 1 recites that the apparatus is adapted to receive instructions that comprises “an action the user of the apparatus should take regarding the individual”. Nothing in the prior art of record teaches, suggests or discloses such a limitation. Accordingly, withdrawal of this rejection is respectfully requested.

*New Claims*

Claims 9-20 have been added. Claims 9-11 depend directly or indirectly from claim 1 and are patentable for at least the same reasons as claim 1. Claims 12-20 are directed to a method of obtaining identifying information of an individual, with claim 12 being the

independent claim. The prior art of record fails to teach, suggest or disclose such a method. Therefore, it is believed that these claims are allowable as well.

### CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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**MARKED-UP SPECIFICATION**

On Page 1, please rewrite the title as follows:

**SYSTEM AND METHOD FOR OBTAINING AND UTILIZING [MAINTENANCE]  
IDENTIFYING INFORMATION OF AN INDIVIDUAL**

**MARKED-UP CLAIMS**

1. (Amended) A hand-held electronic security apparatus adapted to allow a user to obtain identifying information of an individual at a first location, the apparatus comprising:

a casing;

a computer disposed within the casing, the computer having a computer program;

a first input device coupled to the computer and adapted to receive identifying information of the individual, the computer being adapted to receive and process identifying information from the first input device; [and]

a storage medium communicating with the computer, the storage medium including a database of identifying information of at least one individual[s], wherein the computer compares [the] identifying information of the individual received from the first input device with the identifying information stored in the storage medium;

a second input device coupled to the computer and adapted to enter remarks into the computer program regarding at least one of the individual and the identifying information;

a transmitter coupled to the computer and adapted to electronically transmit at least one of the identifying information and remarks to a second location remote from the first location;

a receiver coupled to the computer and adapted to receive instructions from the second location, the instructions comprising an action the user of the apparatus should take regarding the individual; and

an output device coupled to the computer and adapted to inform the user of the apparatus of the instructions.

2. (Amended) The apparatus according to claim 1, wherein the identifying information includes [at least one of the] an image of [an] the individual.

3. (Amended) The apparatus according to claim 2, [further comprising] wherein the first input device comprises a camera coupled to the computer and adapted to obtain an image of the individual.

4. (Amended) The apparatus according to claim 2, wherein the output device comprises [further comprising] a display coupled to the computer and adapted to display the image.
5. (Amended) The apparatus according to claim 1, wherein the apparatus is adapted to communicate with a remote location to [at least one of transmit and] receive identifying information.